REMARKS

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-3, 7-9, and 13-15 are presently pending. Claims amended herein are 1 and 7. Claim withdrawn or cancelled herein is

5   none. New claims added herein are none.

Claim Amendments

The amendments to claims 1 and 7 are not substantive. Instead, they are merely intended to correct a grammatical issue.

Substantive Claim Rejections

10   ## Claim Rejections under §§ 102 and 103

The Office rejects all of the pending claims (1-3, 7-9, and 13-15) under §102 and/or §103. For the reasons set forth below, the Office has not shown that one or more of the cited references anticipate the rejected claims. For the reasons set forth below, the Office has not made a *prima facia* case showing

15   that the rejected claims are obvious (under §103). Accordingly, Applicant respectfully requests that the rejections be withdrawn and the case be passed along to issuance.

The Office's rejections are based upon the following references:

- **Venkatraman:** *Venkatraman et al.,* US Patent No. 6,014,688
20   (issued 1/11/2000 and filed 4/25/1997); and/or

- **Narayen:** *Narayen et al.,* US Patent No. 6,035,323 (issued 3/7/2000 and filed 10/24/1997).

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Applicant respectfully traverses the rejections and requests reconsideration and allowance of all of the claims in light of the comments and amendments contained herein. Accordingly, Applicant requests that the rejections be withdrawn and the case be passed along to issuance.

5

Overview of the Application

The Application describes a technology for facilitating the ease of handling and exchange of digital images. A set of selected digital images are collected together into a self-contained package called a photo album. These

10 images may be of differing digital formats. Alternatively, they may be all converted onto a common format.

The album includes the selected images and executable software to view such images. This album may be transmitted (typically, via email) to another via a network, such as the Internet.

15

Cited References

The Office cites **Venkatraman** as its reference for is anticipation-based rejections and the primary references in its obviousness-based rejections. The Office cites **Narayen** as its secondary reference in its obviousness-based

20 rejections.

Venkatraman

Venkatraman describes an E-mail message enhancement apparatus which is implemented through a sequence of program instructions. On the

25 sender side, creation software implements a data format that allows for differing types of content, such as visual images, audio, multimedia, and

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functional attributes such as links to a sender's home page on the World Wide Web. Furthermore, in addition to such content in the E-mail message, there is included header information, including the E-mail address of the sender, and recipient executable embedded software that ensures the recipient will be able

5 to view contents and perform the functional attributes that make up the E-mail message.

Narayen

Narayen describes technology for publishing a collection of digital

10 media on a network. In one example of a method, a client digital processing system generates a collection of digital media and transmits collection information, which describes the collection of digital media, to a server digital processing system. From the collection information, a plurality of presentable media is automatically generated; each of these presentable media is capable of

15 being presented to other client digital processing systems which are coupled to the network. In this one example, the network is operating according to a hypertext transfer protocol. In this one example, the client and server systems are programmed to interact together such that the presentable media is automatically generated.

20

Anticipation Rejections

Anticipation Rejections Based upon Venkatraman

The Office rejects claims 1-3 and 7-9 under USC § 102(b) as being

25 anticipated by **Venkatraman**. Applicant respectfully traverses the rejections

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of these claims. Based on the reasons given below, Applicant asks the Office to withdraw its rejections of these claims.

Claim 1

5   In the Action (pp. 2-3), the Office provides the following reasoning for rejecting this claim:

9.   With respect to Claim 1, Venkatraman teaches a method for facilitating the ease of handling and exchange of digital images, the method comprising: obtaining a set of images have a digital-image format that differs from the digital-image format of one or more of the other images of the set of multiple images (Col. 5 lines 62-67); facilitating selection of images from the set, wherein one or more of the selected images have a digital-image format that differs from the digital-image format of one or more of the other selected images (Col. 6 lines 51-66 and Col. 5 lines 62-67); choosing computer-executable instructions for viewing selected images, wherein the chosen computer-executable instruction facilitates viewing of selected images in each of the differing digital-image formats of the selected images (Col. 6 line 51- Col. 7 line 5 and Col. 3 line 56 - Col. 4 line 12); collecting the selected images into a self-contained album, wherein the album comprises the selected images and the chosen computer-executable instruction for viewing the selected images (Col. 6 line 51- Col. 7 line 5 and Col. 3 line 56 - Col. 4 line 12).

      In part, this claim reads:

10   •   obtaining a set of multiple digital images, wherein one or more of the images of the set of multiple digital images are a digital-image format that differs from the digital-image format of one or more of the other images of the set of multiple images;

       •   facilitating selection of images from the set, wherein one or more

15   of the selected images are a digital-image format that differs from

the digital-image format of one or more of the other selected images;

- choosing computer-executable instructions for viewing selected images, wherein the chosen computer-executable instructions facilitate viewing of selected images in each of the differing digital-image formats of the selected images;

- collecting the selected images into a self-contained album, wherein the album comprises the selected images and the chosen computer-executable instructions for viewing the selected images.

Applicant submits that **Venkatraman** does not disclose "obtaining a set of multiple digital images" in which "one or more of the images of the set of multiple digital images are a digital-image format that differs from the digital-image format of one or more of the other images of the set of multiple images."

Instead, **Venkatraman** merely discloses a list of possible digital-image formats for its subject digital images. Specifically, the cited text of **Venkatraman** (col. 5, lines 62-67) states:

> The Data Location refers to whether data for the component object requires looking to a data field, fetching data using a URL, or an absolute offset. The data field may be a digital data field that contains digital data, such as digital images from, for instance, a GIF, a video sequence, an audio sequence, or other representations of images.

Applicant submits that **Venkatraman** fails to disclose that its subject digital images in its "container" include images of differing formats. While the above cited text indicates that the digital images in **Venkatraman's** containers are not limited to any particular digital format, Applicant submits that this is not equivalent to specifying that images in the container differ in format.

Indeed, Applicant respectfully submits that, without an explicit statement in **Venkatraman** that its container included images of differing

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formats, it is reasonable to assume that all of the images in its containers have the same digital-image format.

Furthermore, Applicant asks that the Office note **Venkatraman's** following cautionary statement at col. 6, lines 56-60: "There can be any

5   number of component definitions desired, with it being understood that the more definitions that exist, the larger the size of the attachment that will ultimately be transmitted." More particularly, Applicant asks the Office to note that **Venkatraman** does not include a similar cautionary statement regarding differing image formats.

10   Since each different format in a container will require its own format-decoding software, then it seems logical for **Venkatraman** to supply a similar cautionary statement if **Venkatraman** contemplated its "container" including images of differing formats. Applicant submits that a lack of a differing-format cautionary statement in **Venkatraman** lends support to Applicant's

15   position that **Venkatraman** fails to disclose that its subject digital images in its "container" include images of differing formats.

Based upon the above reasoning, Applicant submits that **Venkatraman** also fails to disclose facilitation of a "selection of images from the set, wherein one or more of the selected images are a digital-image format that differs from

20   the digital-image format of one or more of the other selected images" or "choosing computer-executable instructions for viewing selected images, wherein the chosen computer-executable instructions facilitate viewing of selected images in each of the differing digital-image formats of the selected image."

25   Applicant submits that **Venkatraman** does not disclose all of the claimed elements and features of this claim. Furthermore, the combination of **Venkatraman** and **Narayen** does not disclose of the claimed elements and

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features of this claim. Accordingly, Applicant asks the Office to withdraw its rejection of this claim.

Claims 2-3

5   These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable.

In addition to its own merits, each of these dependent claims is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each of these dependent

10   claims because its base claim is allowable.

Claim 7

In the Action (pp. 3-4), the Office provides the following reasoning for rejecting this claim:

12.   With respect to Claim 7, Venkatraman teaches a method for generating a self-contained album of digital images, the method comprising: inserting images into an album, wherein one or more of the inserted images have a digital-image format that differs from the digital-image format of one or more of the other inserted images (Col. 6 lines 51-66 and Col. 5 lines 62-67), choosing computer-executable instructions for viewing inserted images, wherein the chosen computer-executable instruction facilitates viewing of inserted images in each of the differing digital-image formats of the inserted images (Col. 6 line 51- Col. 7 line 5 and Col. 3 line 56 - Col. 4 line 12); inserting the chose computer-executable instructions into the album (Col. 6 line 51- Col. 7 line 5 and Col. 3 line 56 - Col. 4 line 12).

15   In part, this claim reads:

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- inserting images into an album, wherein one or more of the inserted images have a digital-image format that differs from the digital-image format of one or more of the other inserted images;

5
- choosing computer-executable instructions for viewing inserted images, wherein the chosen computer-executable instructions facilitate viewing of inserted images in each of the differing digital-image formats of the inserted images;
- inserting the chosen computer-executable instructions into the

10   album.

Applicant submits that **Venkatraman** does not disclose "inserting images into an album, wherein one or more of the inserted images have a digital-image format that differs from the digital-image format of one or more

15 of the other inserted images."

Instead, **Venkatraman** merely discloses a list of possible digital-image formats for its subject digital images. See cited of **Venkatraman** (col. 5, lines 62-67) above at page 11.

Applicant submits that **Venkatraman** fails to disclose that its subject

20 digital images in its "container" include images of differing formats. While the above cited text indicates that the digital images in **Venkatraman's** containers are not limited to any particular digital format, Applicant submits that this is not equivalent to specifying that images in the container differ in format.

Indeed, Applicant respectfully submits that, without an explicit

25 statement in **Venkatraman** that its container included images of differing formats, it is reasonable to assume that all of the images in its containers have the same digital-image format.

Based upon the above reasoning, Applicant submits that **Venkatraman** also fails to disclose "choosing computer-executable instructions for viewing

inserted images, wherein the chosen computer-executable instructions facilitate viewing of inserted images in each of the differing digital-image formats of the inserted images."

5   Applicant submits that **Venkatraman** does not disclose all of the claimed elements and features of this claim. Furthermore, the combination of **Venkatraman** and **Narayen** does not disclose of the claimed elements and features of this claim. Accordingly, Applicant asks the Office to withdraw its rejection of this claim.

10   *Claims 8-9*

    These claims ultimately depend upon independent claim 7. As discussed above, claim 7 is allowable.

    In addition to its own merits, each of these dependent claims is allowable for the same reasons that its base claim is allowable. Applicant

15 submits that the Office withdraw the rejection of each of these dependent claims because its base claim is allowable.

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

20   Applicant disagrees with the Office's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a *prima facie* case have not been met.

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Based upon Venkatraman and Narayen

The Office rejects claims 13-15 under USC § 103(a) as being unpatentable over **Venkatraman** in view of **Narayen**. Applicant respectfully traverses the rejection of this claim. Applicant asks the Office to withdraw its

5   rejection of this claim.

Claim 13

In the Action (pp. 4-5), the Office provides the following reasoning for rejecting this claim:

a method for facilitating the ease of handling and exchange of digital images, the method comprising: collecting images into a self-contained album, wherein one or more of the collected images have a digital-image format that differs from the digital-image format of one or more of the other collected images (Col. 6 lines 51-66 and Col. 5 lines 62-67). Venkatraman does not explicitly disclose converting one or more of the collected images into a common digital-image format so that all of the collected images have the same common digital-image format. Narayen teaches converting selected images of an album into a common format in order to facilitate distribution of digital images over a network (Col. 8 lines 38-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method taught by Morag and modify it as indicated by Narayen such that the method further comprises converting the selected images into a common format. One would be motivated to have this as there is need for easily distributing and sharing digital images over a network, such as the internet (Col. 2 lines 27-31 and Col. 8 lines 38-45 of Narayen).

10

In part, this claim reads:

- collecting images into a self-contained album, wherein one or more of the collected images have a digital-image format that differs from the digital-image format of one or more of the other collected images;

5

- converting one or more of the collected images into a common digital-image format so that all of the collected images have the same common digital-image format;

10

- inserting computer executable instructions for viewing the collected images.

Applicant submits that **Venkatraman** does not disclose "collecting images into a self-contained album, wherein one or more of the collected

15   images have a digital-image format that differs from the digital-image format of one or more of the other collected images."

Instead, **Venkatraman** merely discloses a list of possible digital-image formats for its subject digital images. See cited of **Venkatraman** (col. 5, lines 62-67) above at page 11.

20   Applicant submits that **Venkatraman** fails to disclose that its subject digital images in its "container" include images of differing formats. While the above cited text indicates that the digital images in **Venkatraman's** containers are not limited to any particular digital format, Applicant submits that this is not equivalent to specifying that images in the container differ in format.

25   Indeed, Applicant respectfully submits that, without an explicit statement in **Venkatraman** that its container included images of differing formats, it is reasonable to assume that all of the images in its containers have the same digital-image format.

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Applicant submits that **Venkatraman** does not disclose all of the claimed elements and features of this claim. Furthermore, the combination of **Venkatraman** and **Narayen** does not disclose of the claimed elements and features of this claim. Accordingly, Applicant asks the Office to withdraw its

5   rejection of this claim.

Claims 14-15

These claims ultimately depend upon independent claim 13. As discussed above, claim 13 is allowable.

10   In addition to its own merits, each of these dependent claims is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each of these dependent claims because its base claim is allowable.

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Dependent Claims

In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is

5   allowable.

Conclusion

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Office is

10   urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

Dated: 7-19-05   By: _____

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